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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/685,685 | 10/15/2003 | Anthony Costa | 0299568-0417 | 7079 |
| 7590 12/19/2006 IP Department Schnader Harrison Segal & Lewis LLP Suite 3600 1600 Market Street Philadelphia, PA 19103 | | | EXAMINER SILVERMAN, ERIC E | |
| | | | ART UNIT 1615 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 12/19/2006 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/685,685 | Applicant(s) COSTA ET AL. | |
| | Examiner Eric E. Silverman, PhD | Art Unit 1615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5-10 and 12-24 is/are pending in the application.
 4a) Of the above claim(s) 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-26 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Applicants' response and amendments, filed 11/2/2006, have been received.

Claims 1, 5 – 10, and 12 – 24 are pending pursuant to amendment.

Election/Restrictions

Newly submitted claims 18 – 24 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claims are directed to a method of using the composition of claims 1 and 5 – 17. However, the composition of claims 1, 5 – 12 and 13 – 17 can be used in a substantially different method, such as a method of binding together two materials by adhesion (i.e. as a glue). Accordingly, the two inventions are independent or distinct, and restriction between them is proper since search of both would constitute an undue burden on the examiner. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18 – 24 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product

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claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Specification

The amendment has remedied the objectionable aspects of the specification.

The objections to the specification articulated in the previous office action are **withdrawn**.

Claim Rejections - 35 USC § 112

The rejections of claims 1, 5 – 10 and 12 – 17 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **are withdrawn** in view of amendment.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claims 1, 5 – 7 under 35 U.S.C. 102(b) as being anticipated by EP 0 625 034 is **withdrawn** in view of amendment.

The rejection of claims 1, 5, 6, under 35 U.S.C. 102(b) as being anticipated by US 4,729,190 to Lee is **withdrawn** in view of amendment.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 **remains** rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,074,438 to Lim et al. Amended claim 15 must now be included in this rejection.

Response to Arguments

Applicants' arguments have been fully considered, but are not persuasive. Applicants' argue that incorporation of the limitations of originally presented claims 2 – 4 into claim 1 overcome this reference. However, as pointed out in the previous office action, this reference rendered originally presented claims 2 – 4 obvious. Thus, the amendment does not overcome this rejection. Note that Aculyn-44 (the copolymer of instant claims) is suggested on col. 8 of Lim. Lim's recitation of "about 10 %" of Aculyn-44 reads on or at least is suggestive of instantly claimed "about 15%".

Claims 5 – 10, 12 rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,074,438 to Lim in view of US 6,447,788 to Strathausen.

The teachings of Lim were discussed previously.

Lim does not teach the medicaments of instant claims.

Strathausen teaches body-care preparations, in particular for use on hair (abstract). These are the same type of preparations taught by Lim. Strathausen suggests inclusion of essentially oils, such as pine oil, in an amount of 1 – 5% (claim 1, col. 3, lines 15 – 31) reading on instant claims 7 – 10, 12 (which mentions pine oil specifically) and 13 (the required amount of oils in the art is the same as that of this claim). Strathausen teaches that inclusion of such oils are give the composition the

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property of providing both a pleasant odor and a health-promoting aromatherapy (col. 3, lines 15 – 31).

It would be prime facie obvious to a person of ordinary skill in the art at the time of the invention to include the oils of Strathausen in the invention of Lim. The motivation comes from Strathausen, who teaches that inclusion of such oils are give the composition the property of providing both a pleasant odor and a health-promoting aromatherapy. Since Strathausen teaches how to incorporate such oils into a body-care product, the artisan would enjoy a reasonable expectation of success.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,074,438 to Lim in view of US 6,447,788 to Strathausen and US 5,573,756 to Lambrechts.

The teachings of Lim and Stathausen are discussed above.

What is lacking is a teaching of a glycol-containing solvent.

Lambrechts teaches that polyethylene glycol with a molecular weight of 200 – 800 is a useful carrier for hair care compositions (claim 1). Polyethylene glycol contains glycol, and is a liquid solvent when the molecular weight is 200 – 800. The polyethylene glycol is used from 35 – 60% by weight, which is commensurate with instant claim.

It would be prime facie obvious to a person of ordinary skill in the art at the time of the invention to use polyethylene glycol with a molecular weight of 200 – 800 as a carrier in the composition of Lim and Stathausen, since Lambrechts recognizes the suitability of polyethylene glycol with a molecular weight of 200 – 800 for this purpose.

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The artisan would enjoy a reasonable expectation of success. Note the following section of MPEP 2144.07.

The selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) (Claims to a printing ink comprising a solvent having the vapor pressure characteristics of butyl carbitol so that the ink would not dry at room temperature but would dry quickly upon heating were held invalid over a reference teaching a printing ink made with a different solvent that was nonvolatile at room temperature but highly volatile when heated in view of an article which taught the desired boiling point and vapor pressure characteristics of a solvent for printing inks and a catalog teaching the boiling point and vapor pressure characteristics of butyl carbitol. "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.).

See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988) (Claimed agricultural bagging machine, which differed from a prior art machine only in that the brake means were hydraulically operated rather than mechanically operated, was held to be obvious over the prior art machine in view of references which disclosed hydraulic brakes for performing the same function, albeit in a different environment.).

Allowable Subject Matter

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Claims 1, 5 – 10, 12 – 16 are rejected. Claim 17 is objected to. Claims 18 – 24 are withdrawn from consideration.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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